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MAR 30 2009

OFFICE OF PETITIONS

In re Application of	:	
Hans Hundegger	:	
Application No. 10/728,773	:	DECISION ON PETITION
Filed: December 8, 2003	:	PURSUANT TO
Attorney Docket No.: P69351US0	:	37 C.F.R. § 1.181(A)
Title: METHOD AND MACHINING	:	
INSTALLATION FOR THE MACHINING	:	
OF WOOD WORKPIECES	:	

This is a decision on the petition filed March 10, 2009, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

This petition pursuant to 37 C.F.R. § 1.181(a) is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 22, 2008, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue¹ or publication fees.² Accordingly, the above-identified application became abandoned on December 23, 2008. A Notice of Abandonment was mailed on January 15, 2009.

¹ See MPEP § 710.02(e) (III).

² See 37 C.F.R. § 1.211(e).

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. **The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney**

docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

(Emphases added).

ANALYSIS

With this petition, Petitioner has stated that the notice of September 22, 2008 was not received at the correspondence address of record,³ and has included a copy of the individual docket record for this application as well as the master docket.

³ Petition, pages 1-2, paragraph 2.

Petitioner has further indicated that he "searched in all of the applicable places at his law office"⁴ and has suggested that he reviewed the file jacket.⁵ The Office will construe these statements to mean that both the file jacket and the application contents were reviewed, and Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this petition.

Petitioner's assertion of non-receipt has not been adequately supported, as the statement that Petitioner has included describing the system used for recording an Office action received at the correspondence address of record with the USPTO is insufficient to either describe the operation of the docketing system or establish the reliability of the same.

Petitioner has indicated that he "uses Computer Packages Inc (CPI) docketing system," and that when a communication is received from the Office, members of his "docketing department" docket the communication "with the mail date, due date, and call ups."⁶

The docketing system appears to be a computer-based system. Does this computer-based docketing software program generate reports that are distributed to the responsible attorneys/agents?

Moreover, the record does not contain an indication of how these "call ups" serve to ensure that docketed Office communications are responded to in a timely manner. Are these "call ups" essentially periodic reminders that are generated by the docketing system prior to the due dates of docketed Office communications? If so, are these reminders distributed to the responsible attorneys/agents?

Similarly, is the master docket reviewed on a periodic basis to ensure that all entries that appear thereon have been responded to in a timely manner?

CONCLUSION

The time period for filing a renewed petition is governed by 37 C.F.R. § 1.181(f). Therefore, if reconsideration of this decision is desired, any response to this decision must be

⁴ Petition, page 1, paragraph 2.

⁵ Id. at page 2, paragraph 5.

⁶ Id. at page 2, paragraph 3.

submitted within **TWO MONTHS** from the mail date of this decision, and **extensions of time under 37 C.F.R. § 1.136(a) are not permitted.** The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁷ hand-delivery,⁸ or facsimile.⁹ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹⁰

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.¹¹ All other inquiries concerning examination procedures or status of this application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

7 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

8 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

9 (571) 273-8300- please note this is a central facsimile number.

10 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

11 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).